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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

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Applicant:

ANTHONY MAGLICA

Serial No. 07/411,576

Filed: September 22, 1989

For: MINIATURE FLASHLIGHT

Art Unit: 2901

Examiner: M. Tung

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BOARD OF PATENT APPEALS
AND INTERFERENCES

REPLY BRIEF

Assistant Commissioner of Patents
Washington, D.C. 20231

Dear Sir:

This reply brief is in response to the new grounds of rejection imposed by the examiner.

CERTIFICATE OF HAND DELIVERY

I hereby certify that this paper (along with any referred to as being attached or enclosed) is being hand delivered on the date shown below to the Commissioner for Patents, Washington, D.C. 20231.

September 4, 2001

Date of Delivery

Robert C. Campbell Jr.

Name of Person Delivering Paper

Robert Campbell Jr.

Signature of Person Delivering Paper

STATEMENT OF INTEREST

The real party in interest for Applicant Anthony Maglica is Mag Instrument, Inc., a California Corporation.

STATEMENT OF RELATED APPEALS

The pending application is related to U.S. Design Application, Serial No. 07/410,965, also filed on September 22, 1989, which was also on appeal before the Board of Patent Appeals and Interferences.

STATUS OF CLAIM

The sole claim for an ornamental design stands rejected.

STATUS OF AMENDMENTS AFTER FINAL REJECTION

A Third Amendment After Final Rejection has been submitted, received on September 5, 1996, and entered by the examiner.

SUMMARY OF THE INVENTION

The invention was summarized in the appeal brief filed on September 5, 1996.

ISSUES

The issues for the reply brief are the two new grounds of rejection imposed in the Advisory Action dated November 12, 1996, and in the Examiner's Answer dated February 21, 1997:

1. Whether the claimed subject matter, as amended in the September 5, 1996, amendment, is unpatentable as being directed to new matter under 35 U.S.C. §112, first paragraph, due to the smooth portion of the barrel

between the threaded end (bulb end) and the knurled barrel allegedly being proportionally longer than shown in the original mechanical drawings.

2. Whether the claimed subject matter, as amended in the September 5, 1996, amendment, is unpatentable as being directed to new matter under 35 U.S.C. §112, first paragraph, due to the outermost and next inwardly concentric lines illustrated in Figure 3 allegedly being spaced too far apart compared to the original mechanical drawings.

GROUPING OF CLAIMS

Since only a single claim is permitted in a design patent application, the grouping of claims is not applicable in the present case.

ARGUMENT

1. FIRST NEW REJECTION

The Examiner indicated that the smooth portion of the barrel between the threaded end (bulb end) and the knurled barrel is proportionally longer than shown in the original formal and the original mechanical drawings. To resolve this, the correct drawing and figure must be considered. The present application was filed with the mechanical drawings under Rule 60. The application was amended by canceling the entire specification and the drawings and preparing a new design application and an appropriate drawing therefor. Consequently, the original drawings in the present application are the mechanical drawings which were copied from prior

applications. It is understood that it is against these drawings which one must compare the propriety of the current formal drawing. Figure 8 is the appropriate Figure to consider because the head covers over a portion of the smooth barrel when the head is in place over the bulb end of the barrel as seen in Figure 1. Only Figure 8 shows the full extent of the barrel at the bulb end which is also shown in the design drawing in the present application.

It is submitted that the space between the threaded end and the knurling is proportional to what is shown in the original mechanical drawings in Figure 8. To illustrate the foregoing comparison, attached hereto is a construction consisting of a copy of Figure 2 of the formal drawings submitted September 5, 1996 and a copy of the original Figure 8 of the mechanical drawings. An arc equal to the length of the exposed barrel between the head and the threaded bulb end was constructed from the intersection of the head and the barrel on the new formal drawing. At a point of tangency between the previously constructed arc and a line extending from the barrel at the threaded bulb end a line was drawn from the intersection of the head with the barrel to that point of tangency. The copy of the mechanical drawing of Figure 8 was then superimposed at that position and parallel lines drawn between the two figures for comparison of ratios. The intersection of these lines with the ends of the knurling show that the ratio is the same between overall length of that barrel and the smooth portion at issue for both the original mechanical drawing of Figure 8 and the current formal drawing.

With a showing that the proportions are identical, and that Figure 8 is the appropriate drawing to consider, applicant believes that the rejection is inappropriate and should not be sustained.

2. SECOND NEW REJECTION

A second issue was raised regarding the spacing of the outermost and next inwardly concentric lines illustrated in Figure 3. The lines were rejected as being spaced too far apart and, therefore, new matter. The outermost line represents the maximum diameter of the head. The next line in is the outer edge of the machined surface on the back end of the head. These are believed to be drawn proportionally consistent with the mechanical drawings. This comparison is illustrated in the attached construction using the above-described technique with Figure 2 of the original mechanical drawings. Figure 2 was picked as it provided the best measure of the two dimensions. As best as it can be determined, the proportion is correct. Figure 3 agrees with the other figures in the formal drawing as well, which were not objected to in this respect.

Again, the figures are correct to the best of applicant's ability as measured from the original mechanical drawings. The rejection should not be sustained.


CONCLUSION

The final rejection, as well as the new grounds of rejection stated in the examiner's answer, should be reversed. Therefore, Applicant respectfully requests that the rejections be reversed and that the present application be allowed.

Respectfully submitted,

LYON & LYON

Date: September 4, 2001

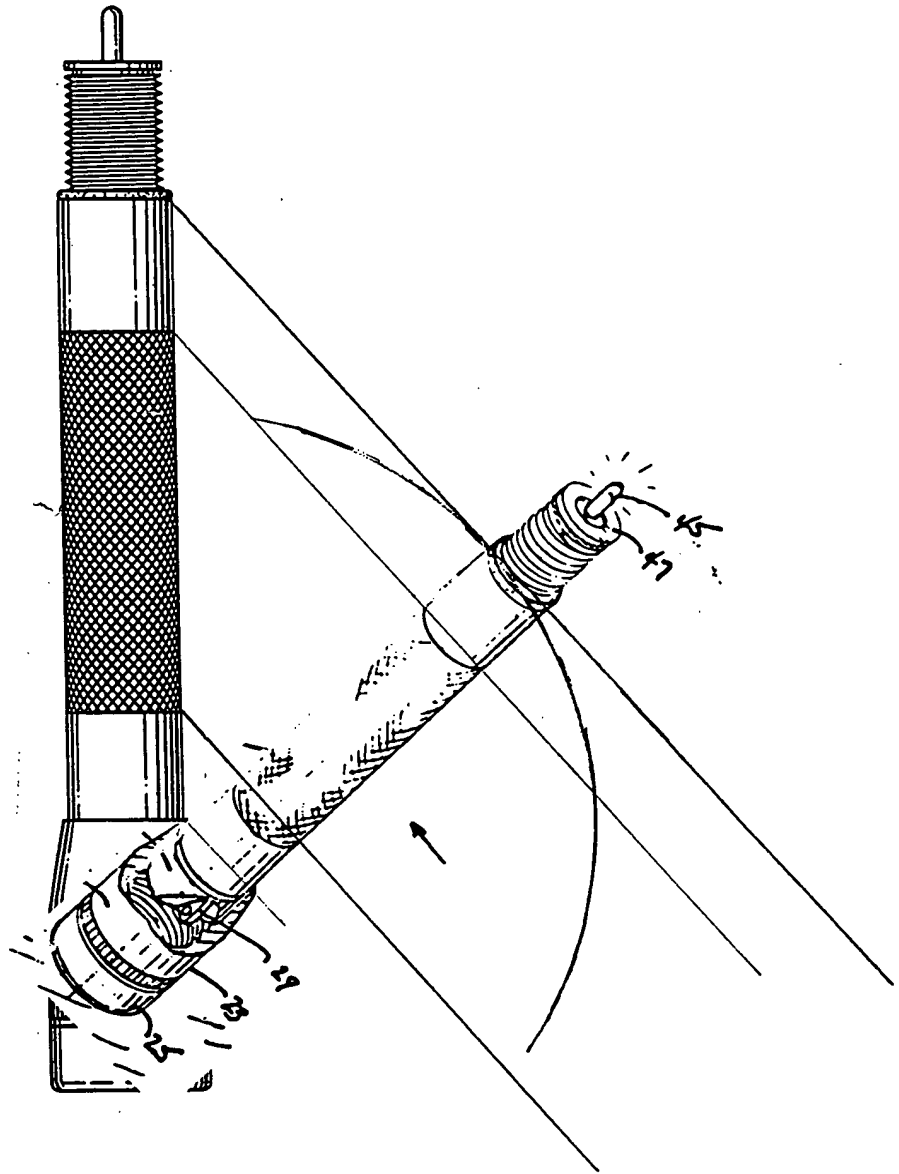
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